

## **REMARKS & ARGUMENTS**

Claims 1-43 are currently pending in this application. Applicant presents various arguments herein about why the claims of the application are patentably distinct from each of the cited references. Also, certain amendments have been made to further clarify Applicant's invention, but without intending to surrender any range of equivalents.

Through this response, claims 12 and 13 have been amended. Certain other amendments were presented by Applicant's prior attorney, on or about 7/27/05, however, the undersigned attorney is not entirely clear whether each of the amendments were added.

Applicant respectfully requests favorable consideration of the present application in light of the amendments to the claims and the following remarks. Further details of claim status and the Examiner's arguments are as follows:

### **§102 Rejections:**

- Claims 1-5, 9 and 12-13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Burgess (U.S. Pat. No. 6,640,465)

### **§103 Rejections:**

- Claims 1-9, 12-18, 20-36 and 39-43 stand rejected under §103(a) as being unpatentable over Turtzo (U.S. App. No. 09/875,357) in view of Burgess.
- Claims 10 and 19 stand rejected under §103(a) as being unpatentable over Turtzo and Burgess and further in view of Shaw (U.S. Pat.No.5,897,518).
- Claims 37-38 stand rejected under §103(a) as being unpatentable over Turtzo and Burgess and further in view of Dalton (U.S. App.No.2004/0118017).

## I. Claim Rejections – 35 USC §102(e)

Claims 1-5, 9 and 12-13 stand rejected under 35 U.S.C. §102 as being anticipated by Burgess (U.S. Pat. No. 6,640,465). Applicant traverses this rejection as set forth below.

In order for a reference to anticipate the present claimed invention under 35 USC §102, it must be shown that each and every element of the claim can be found in the reference. If it can be shown that one element of the claim is missing or not met by the cited reference, the rejection must be withdrawn as inappropriate.

Applicant objects to the assertion of Burgess is even prior art because (1) it is outside the field of Applicant's technology and (2) because it does not anticipate Applicant's claims, which are for a plantar fascia support system. Burgess speaks to a sheet of adhesive adapted to keep a person's foot clean. The Burgess patent is structurally, functionally, and operationally different from Applicant's technology.

Applicant's attorney has read Burgess, including the referenced figures, claims, and columns in the specification referenced by the Examiner; however, cannot locate any portion of the Burgess patent that speaks to either a "A method for managing stress on a plantar fascia..." (Applicant claim 1-5, 9) or "a system for managing pain in the human foot..." (Applicant claim 12, 13).

Thus, with respect to Claim 1-5 and 9, Burgess does not teach a "**method for managing stress on a plantar fascia**" and fails to anticipate Applicant's invention. Moreover, with respect to claim 1, Burgess does not teach a principal limitation of claim 1, which is "...**controlling tension in at least a portion of the plantar fascia of the**

***foot, wherein said tension is shared between the plantar fascia and said support device.***" This is because Burgess was not invented for any purpose of managing stress or sharing tension on a plantar fascia, but rather for purposes, as described in the Background of the Invention section (column 1), for "...situations in which a person is faced with the prospect of walking barefoot across surfaces of indeterminate cleanliness..." Burgess simply does not treat or teach any method of controlling or sharing tension of the plantar fascia.

Because Claims 2-5 and 9 depend from Claim 1 and only further delimit claim 1, Applicant urges that the rejections to these claims are also defeated inasmuch as independent claim 1 is not anticipated by Burgess as contemplated by 35 U.S.C. §102. Because the Burgess reference is silent with respect to at least one element of amended claim 1, it is respectfully requested that the rejection of claim 1 in the Office Action be withdrawn. Claim 1 is believed to be in proper condition for allowance and an indication of such is hereby earnestly solicited.

With respect to Claims 12-13, Burgess does not speak to a "***system for managing pain in a human foot...***" On the contrary, Burgess speaks only to creating a superficial barrier which may be adhered to a foot. Moreover, Burgess does not teach the limitation of a device where ***tension is shared between the plantar fascia and said support device to control stress in at least a portion of the plantar fascia.*** To the extent that claims 12-13 originally supplied this limitation in a "whereby" clause, a suitable amendment has been made to clearly add this limitation.

Claims 2-11, being dependent upon and further limiting independent claim 1, should be deemed allowable for the reasons set forth in support of the allowability of claim 1, as well as the additional features they contain.

## II. Claim Rejections – 35 USC § 103(a)

Claims 1-9, 12-18, 20-36 and 39-43 stand rejected under §103(a) as being unpatentable over Turtzo (U.S. App. No. 09/875,357) in view of Burgess. To the extent that individual rejections may be deciphered by applicant, these “obviousness” rejections are further discussed herein on a claim-by-claim basis.

Initially, however, Applicant argues that a proper *prima facie* case of obviousness has not been shown with respect to Turtzo and Burgess and with respect to Applicant’s invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§2142-2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2142-2143. Finally, in determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

In the instant case, one skilled in the art would not have combined the teachings of Turtzo and Burgess because: (1) to do so would significantly teach away from the limitations of Applicant's invention and (2) because there is no suggestion or motivation anywhere, in either of the references, to make such a combination of Turtzo and Burgess. Turtzo is completely opposed to Applicant's invention because it teaches a *splint*. A splint is bulky, worn more like a shoe, and not under shoes. Also, Burgess never mentions a *splint*, and is not geared toward treating plantar fasciitis. See arguments above. A splint, such as disclosed by Turtzo, is not configured for placement under the socks as urged and this combination was not made or suggested in either of the references.

The Turtzo application speaks at length, in the "Background of the Invention" about how a splint is provided to accomplish "dorsiflexion," the term being defined as securing the foot at an angle less than 90 degrees to the leg. There is no suggestion in Burgess to such a treatment, or for any treatments or methods of treating plantar fasciitis. Burgess is a device for keeping feet clean and protected from exposure, not for treating ailments. Also, applicant disputes that Fig. 4 of Turtzo teaches "controlling tension in at least a portion of the plantar fascia of the foot, wherein said tension is shared between the plantar fascia and the support device...") (Claim 1). On the

contrary, Fig. 4 shows a portion of Turtzo's rigid splint being used and shaped to create a dorsiflexion, or simultaneous elevation of the toes and heel to *stretch* the plantar fascia of the foot. This could actually be construed as adding tension, as opposed to sharing of tension. This method teaches away from Applicant's invention, inasmuch as it involves intentional stretching, versus sharing stress or tension to limit stretching.

The inventions of Burgess and Turtzo are so structurally different, and for such different purposes, that no reasonable person skilled in the relevant art would have been motivated to make the combinations of applicant's invention. Turzo is a rigid splint. Any combination, or attempted combination, of these combinations would not result in a product that could be worn with normal footwear or under a shoe. In addition, it should be noted that Burgess and Turtzo both require cushions, whereas Applicant's device has no such requirement. Also, Burgess and Turtzo both teach matching the outline of the entire sole of the foot, whereas embodiments of Applicant's invention do not have this requirement of matching the outline of the sole. An amendment has been made to claim 13 to clarify this point.

Further, even if hypothetically combined, neither of the references teach "controlling tension in at least a portion of the plantar fascia of the foot..." or sharing of tension on the arch, as provided in Applicant's claim 1, and all claims ultimately depending therefrom, including 2-11,21-23, 31,33, 35, 37, 39, 41, or 43. For the same reason, Applicant disputes that a claim of *prima facie* obviousness has been made that Burgess and Turtzo are combinable, or would have been combined, to teach the limitations of amended claim 12 and all claims ultimately depending therefrom.

Also, to the extent rejections are being made to claims 5 and 41, Applicant wishes to point out what appears to be a simple error in the Examiner's argument. Namely, the limitation of "less than 30 mils.." is not anticipated by the Burgess range of 2-5 millimeters. A "mil" is not a metric unit of measurement and is actually much smaller than the range of Burgess. A "mil" is a measurement equaling one thousandth of an inch, therefore, neither the Burgess or Turtzo references anticipate these claims. A 30 mil thickness would be about .763 mm, or significantly below the minimum 1.0 mm thickness of the Burgess disclosure. Burgess and Turtzo actually speak to cushions and "cushioning" effects, so they teach away from Applicant's device.

**Claims 7, 8—35 USC § 103(a)—Turzo & Burgess**

In addition to the general arguments raised above to the combination of Turzo and Burgess, a *prima facie* case of obviousness has not been made that these two references would have been combined, or that they could have been combined to teach the limitations of claims 7, 8, 31, 32. There was no suggestion in the references to combine these specific limitations.

**Claims 21-23, 25-27—35 USC § 103(a)—Turzo & Burgess**

In addition to the general arguments raised above to the combination of Turzo and Burgess, a *prima facie* case of obviousness has not been made that these two references would have been combined, or that they could have been combined to teach the limitations of claims 21-23, 24-28, or 25-27. No explanation is offered in the action about how these two references might have been combined to teach the limitations of

these claims, or where there might be any suggestion or motivation to make the combination.

**Claims 10 and 19—35 USC § 103(a)—Shaw**

Claims 10 and 19 stand rejected under §103(a) as being unpatentable over Turtzo and Burgess and further in view of Shaw (U.S. Pat.No.5,897,518). In addition to the general arguments raised above to the combination of Turtzo and Burgess, a *prima facie* case of obviousness has not been made that these three references would have been combined, or that they could have been combined to teach the limitations of claims 10 and 19. Neither of these references speak to use of an indicia that “...includes indicia that indicate the *order* in which portions of said support device are attached to the foot...” The portion of the Shaw reference cited by the Examiner only discloses indicia being used, such as crossed lines that help *center* the device. More importantly, however, there is no suggestion that these references would ever have been combined by those skilled in the art and the limitations are not taught.

**Claims 37-38—35 USC § 103(a)—Dalton**

Claims 37-38 stand rejected under §103(a) as being unpatentable over Turtzo and Burgess and further in view of Dalton (U.S. App.No.2004/0118017). In addition to the general arguments already raised above to the combination of Turtzo and Burgess, a *prima facie* case of obviousness has not been made that these three references would have been combined, or that they could have been combined to teach the limitations of claims 37 and 38. Dalton would not have been combined to teach the limitations of the present application because Dalton is an *insole*. An insole conceptually teaches away from the inventive concepts of the present invention and the

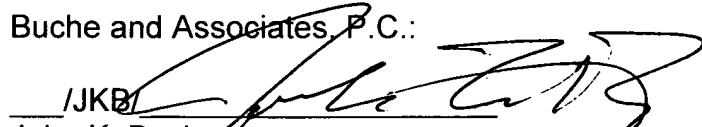
combination would not have been made by one skilled in the relevant art. An insole is secured within a shoe, not to a foot.

Considering each of the foregoing arguments, there is no indication that either of the references, standing together or alone, would have been combined or taught the limitations of the present invention. Applicant respectfully traverses each of the rejections and urges that a *prima facie* case of obviousness has not been made. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§2142-2143. Applicant therefore respectfully requests a withdrawal of a finding of obviousness under 35 USC § 103 with respect to this claim.

**CONCLUSION**

The foregoing amendments have been submitted to place the present application in condition for allowance. Favorable reconsideration and allowance of the claims in this application is respectfully requested. In the event that there are any questions concerning this Amendment or the application in general, the Examiner is cordially invited to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,

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